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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/702,625	08/23/1996	HERMANN KLUTH	H1215/1556PC	6917

423 7590 01/03/2003

HENKEL CORPORATION
2500 RENAISSANCE BLVD
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GULPH MILLS, PA 19406

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

9d

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/702,625

Applicant(s)

KLUTH ET AL.

Examiner

John m Cooney

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-- Th MAILING DATE of this communication app ars on the c ver she t with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-36 and 40-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-36 and 40-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 30.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continued Prosecution Application

The request filed on 5-24-02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/702,625 is acceptable and a CPA has been established. An action on the CPA follows:

At the outset, applicants should note that the date for EP-0,655394 has been corrected on applicants' provided PTO-1449 to recite 5/31/95 which is the publication date. If further correction is believed necessary, then applicants should note such on response and provide a copy of the provided PTO-1449 if new initials by examiner are needed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 15-36 and 40-65 are rejected under 35 U.S.C. 102(e) as being anticipated by WO-94/18,256.

WO-94/18,256 discloses preparations of polyurethanes dispensed from pressure can for dispensing polyurethane foam materials wherein a foam precursor material, which comprises isocyanate group containing prepolymers, blowing agents, catalysts, and other additives, as well as, isocyanate monomer contents of below 2%, is stored under pressure and foamed upon release (see the entire document).

The following rejection was set forth previously on appeal, and is accompanied with the arguments made in the Examiner's Answer dated 6-20-00.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-36, and 40-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauls(4,263,412) in view of Schmalsteig et al.(CA-2,084,698) and Minato et al.(5,086,175)

Pauls discloses preparations of polyurethanes dispensed from a pressure can for dispensing polyurethane foam materials wherein a foam precursor material comprising isocyanate group containing prepolymers, blowing agents, catalysts, and other additives is stored under pressure and foamed upon release (see the entire document).

Pauls differs from applicants' claims in that it does not particularly specify the removal of residual monomeric isocyanate from its reactive components. However, CA-2,084,698 and Minato et al. (see both documents in their entireties) set forth that the means for removing excess monomer from isocyanate based reactive materials has long been known to the art for the purpose of reducing toxicity. CA 2,084,698 sets forth the more commonly recognized distillation method, and Minato et al. discloses the film evaporation methods. Accordingly, it would have been obvious for one having ordinary skill in the art to have reduced residual monomer contents of the prepolymers placed in the systems of the Pauls reference by the methods set forth by CA-2,084,698 and/or Minato et al. for the purpose of reducing toxicity in order to arrive at the systems, processes, and products of applicants' claims in the absence of a showing of new or unexpected results.

Pauls further differs from claims 66-68 in that it is not concerned with readying its cans for non-toxic disposal by reacting unreacted isocyanate with catalysts and/or polyol. However, these are notoriously well known means of neutralizing isocyanate, and if one had interest in environmental concerns they would have prima facie motivated to make the monetary expense for additional materials to neutralize the isocyanate in the expended packs and ready them for proper disposal. Accordingly, it would have been obvious to use conventional isocyanate neutralizing materials on the residues left in the containers of Pauls for the purpose of rendering the containers biologically safe with the expectation of success in the absence of a showing of new or unexpected results.

(11) Response to Argument

Appellants' argue that the references are from non-analogous art. It is maintained that the determination that a reference is from a nonanalogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined

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whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. Disclosures of preparing isocyanate components for polyurethane synthesis having reduced monomeric isocyanate contents is at least pertinent to the endeavors of a referenced inventor who is using isocyanates in preparations of isocyanate components used in prepolymers which are dispensed from cans. The fact that the secondary references may not form foams does not negate their pertinence and relevance to the endeavor of preparing polyurethane products whose fundamental behaviors at a chemical level are not affected by the presence or absence of a blowing agent. Accordingly, it is maintained that an ordinary practitioner in the polyurethane arts would find the teachings of CA-2,084,698 and Minato et al. relevant and pertinent to the teachings of Pauls.

Applicants' maintain that there is no motivation to incur the expenses associated with the combination of references. The fact that these efforts may be expensive relative to their environmental benefits has no bearing on whether motivation is evident. An ordinary practitioner in the art would logically and obviously be directed towards using low toxic monomer containing prepolymers available to him in a prepolymer dispensing system if environmental integrity was at the forefront of his endeavors. Applicants' invention as claimed is utilizing that which is known to the art to the achievement of obvious ends and no invention in a patentable sense is seen. Interest in environmental safety is motivation to avoid toxic materials.

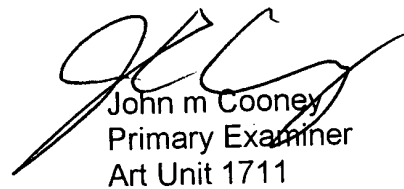
Rejection is maintained as stated above for all claims, and no further arguments concerning individual claims are held to be needed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John m Cooney whose telephone number is 703-308-2433. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, james seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



John m Cooney
Primary Examiner
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